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PATENT
Customer No. 22,852
Attorney Docket No. 04284.0845-06

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Reissue Application of:)
)
U.S. Patent No.: 6,145,023) Group Art Unit: 2182
)
Inventor: Hiroshi IWASAKI) Examiner: Rehana Perveen
)
Issued: November 7, 2000)
)
Serial No.: 09/826,896 ✓)
)
Filed: April 6, 2001 ✓)
)
For: INFORMATION STORAGE AND)
INFORMATION PROCESSING)
SYSTEM UTILIZING STATE-)
DESIGNATING MEMET)
PROVIDED ON SUPPORTING)
CARD SURFACE WHICH)
PRODUCES WRITE-PERMITTING)
OR WRITE-INHIBITING STATE)

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Commissioner for Patents
Washington, DC 20231

Sir:

INFORMATION DISCLOSURE STATEMENT UNDER 37 C.F.R. § 1.97(b)

Pursuant to 37 C.F.R. §§ 1.56 and 1.97(b) and M.P.E.P. § 2001.06(c), Applicant brings to the attention of the Examiner the following information and documents listed on the attached PTO 1449 form. This Information Disclosure Statement is being filed after a Final Office Action and is accompanied by the fee of \$180.00 as specified under 37 C.F.R. § 1.17(p) and a certification as specified under § 1.97(e). Applicant respectfully requests that the Examiner consider the following information and the listed documents and indicate that they were considered by making appropriate notations on the attached PTO 1449 form.

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Three patents, U.S. Patent Nos. 6,094,697 (the '697 patent), 6,292,850 (the '850 patent), and 6,338,104 (the '104 patent), which share a common disclosure with this reissue application, are currently involved in a litigation styled Toshiba Corporation v. Lexar Media, Inc., No. C 03-00167, currently pending in the United States District Court Northern District of California, San Francisco Division. In that litigation, on March 5, 2005, Defendant Lexar Media, Inc. filed its Corrected Answer to Toshiba Corporation's Amended Complaint for Patent Infringement, a copy of which is attached. There, Lexar asserted, without identifying the prior art being relied on, that "[t]he patents at issue [which include the '697, '850, and '104 patents] are invalid for failure to meet the conditions for patentability of 35 U.S.C. § 101 et seq., including, without limitation §§ 102, 103 and 112." See page 6, ¶ 64 of Lexar's Corrected Answer.

In its Corrected Answer, Lexar also contends that the '697, '850, and '104 patents are unenforceable for inequitable conduct. Lexar contends that European Patent Publication No. 622760A1 (the '760 publication), which has the same inventor as this application and of the '697, '850, and '104 patents and which, like this application and the '697, '850, and '104 patents, is assigned to Kabushiki Kaisha Toshiba, is material prior art. See pages 9-10, ¶ 73 of Lexar's Corrected Answer. Lexar also contended that "[f]ailure to disclose EP '760 by the Applicant constituted inequitable conduct." See *id.* Lexar further contended that the '760 publication alone or in combination with at least Japanese Patent Publication 64-55691 "was material to the patentability of the claims of the '696 patent [sic], not cumulative to the information which was made of record in the prosecution history and was withheld from the U.S. Patent and Trademark Office with an intent to deceive." See *id.*

Japanese Patent Publication 64-55691 and a full English language translation thereof were cited to the Office in an Information Disclosure Statement dated June 1, 2001, in this

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reissues application and were indicated as being considered by the Office in an Office Action dated November 29, 2001. In addition, Japanese Patent Publication 64-55691 and a full English language translation thereof were cited to the Office in an Information Disclosure Statement dated September 28 1999, in the application that preceded this reissues application and were indicated as being considered by the Office in a Notice of Allowance dated June 14, 2000.

The attached PTO 1449 form lists the '760 publication. In accordance with 37 C.F.R. § 1.97, Applicant submits that based on reasonable inquiry, the allegations of the materiality or of inequitable conduct made by Lexar in the pending litigation between Toshiba and Lexar based on the '760 publication were not cited in a communication from a foreign patent office in a counterpart foreign application, and that the allegations of the materiality or of inequitable conduct made by Lexar in the pending litigation between Toshiba and Lexar based on the '760 publication were not known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing date of this Information Disclosure Statement.

Applicant also submits herewith Japanese patent document 52-130729, which was first cited a communication from the Japanese Patent Office in a counterpart foreign application. This Information Disclosure Statement is being filed within three months of the mailing date of that communication. The following is a concise statement of the relevance of Japanese patent document 52-130729, which is a non-English language document. This utility model application discloses a magnetic sound recording machine using a mis-erasure prevention circuit to detect a conductive metal label on a tape cartridge.

Copies of the listed documents are attached.

This submission does not represent that a search has been made or that no better art exists and does not constitute an admission that each or all of the listed documents are material or

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constitute "prior art." If the Examiner applies any of the documents as prior art against any claims in the application and Applicant determines that the cited documents do not constitute "prior art" under United States law, Applicant reserves the right to present to the Office the relevant facts and law regarding the appropriate status of such documents.

Applicant further reserves the right to take appropriate action to establish the patentability of the disclosed invention over the listed documents, should one or more of the documents be applied against the claims of the present application.

If there is any fee due in connection with the filing of this Statement, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 28, 2003

By: 

Doris Johnson Hines
Reg. No. 34,629

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